

REMARKS

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

I. CLAIM STATUS & AMENDMENTS

Claims 1 and 3 were pending in this application when last examined, and stand rejected.

Claims 1 and 3 are amended to be in "consisting of" format and to clarify that "carboxylated synthetic chloroprene rubber" is the "main ingredient of the adhesive composition" as supported by the disclosure at page 3, lines 28-30 and as exemplified at page 4, lines 10-17 (Table 1) and at page 6, lines 7-20 (Table 3).

Therefore, no new matter has been added by this amendment.

II. OBVIOUSNESS REJECTIONS

Claim 1 remains rejected under 35 U.S.C. § 103(a) as obvious over Sato et al., US 5,753,727. See item 2 on page 2 of the Office Action.

It is respectfully submitted that the present amendment overcomes this rejection.

Amended claim 1 calls for a synthetic chloroprene rubber adhesive composition, which consists of: (1) 100 parts by weight of carboxylated synthetic chloroprene rubber as a main ingredient of the adhesive composition; and (2) 1-30 parts by weight of chlorinated polypropylene and/or chlorinated polypropylene derivatives, wherein said chlorinated polypropylene derivative is acrylic-monomer-and-methacrylic-monomer-grafted chlorinated polypropylene.

Accordingly, the amended claims call for carboxylated chloroprene rubber as the main ingredient of the adhesive composition, and the claims exclude the presence of uncarboxylated chloroprene rubber.

Sato fails to teach carboxylated chloroprene rubber as the main ingredient of an adhesive composition in the amounts claimed. In fact, as set forth in the last response, Sato describes a composition containing large amounts of uncarboxylated chloroprene rubber. Specifically, Sato discloses an adhesive composition wherein uncarboxylated chloroprene rubber or a 50:50

combination of uncarboxylated chloroprene rubber and carboxylated chloroprene rubber are the main component. Thus, the adhesive composition in Sato contains 50% or more of uncarboxylated chloroprene. Consequently, Sato fails to disclose or suggest carboxylated chloroprene rubber as the main ingredient.

Furthermore, the above amended claims, by way of the “consisting of” language, exclude the presence of uncarboxylated chloroprene rubber. The presence of uncarboxylated chloroprene rubber substantially affects the basic novel properties of the claimed adhesive as evidenced by the Okuzawa Declaration attached to the last response. This Declaration demonstrates that the composition of the present invention is superior to the prior art composition. Specifically, it describes experiments clearly showing that the 50% replacement of the carboxylated chloroprene rubber by the chloroprene rubber, whereby the carboxylated chloroprene rubber is not the main component, actually deteriorates the adhesive strength of the adhesive composition. Compare the test data for Examples 3 and 4 with that of 5 and 6 in the Table attached to the Declaration. Accordingly, large amounts of uncarboxylated chloroprene rubber (i.e., the material excluded from the amended claims) materially effect the basic properties of the resultant adhesive composition. Thus, the prior art compositions in Sato, especially, Examples 15-17 in Table 3 of Sato, fail to disclose or suggest the adhesive composition of the present invention.

Furthermore, Sato lacks a suggestion to use carboxylated chloroprene rubber as the main ingredient, because Sato does not discuss the effect of carboxylated chloroprene rubber on adhesive properties. See the arguments on page 4 of the response filed October 4, 2004.

In fact, Sato teaches away from the claimed composition, because Sato’s composition contains large amounts of uncarboxylated chloroprene, which is excluded from the amended claims.

Therefore, Sato cannot be said to disclose or suggest the use of carboxylated chloroprene rubber as the main ingredient of the adhesive composition, and the amended claims exclude the presence of large amounts of uncarboxylated chloroprene rubber as disclosed in Sato.

With regard to the suggestion on pages 3-4 of the Office Action to amend “parts by weight” to “PHR”, the term “PHR” is used for a relative amount against an amount of the main

ingredient defined as 100 parts. Accordingly, in the present case, it is not correct to recite the amount of the “carboxylated synthetic chloroprene rubber” in “PHR”.

In view of the above, rejection of claim 1 under 103(a) is untenable, and should be withdrawn.

Claim 3 remains rejected under 35 U.S.C. § 103(a) as obvious over Sato in view of the admitted state of the prior art. See item 3 on page 2 of the Office Action.

It is respectfully submitted that the present amendment overcomes this rejection for the same reasons noted immediately above. For these reasons, the rejection of claim 3 under 35 U.S.C. § 103(a) is untenable, and should be withdrawn.

Claims 1 and 3 remain rejected under 35 U.S.C. § 103(a) as obvious over the admitted state of the prior art in view of Smith, US 3,347,847 and/or Kirk-Othmer Encyclopedia of Chemical Technology (sections 3.4 and 8.2), and optionally further in view of Sato and/or the Abstract of JP1-153781. See item 4 on pages 2-3 of the Office Action.

It is respectfully submitted that the present amendment overcomes this rejection for the same reasons noted immediately above, and for the following reasons.

The deficiencies of Sato and the alleged admitted state of the prior art have been discussed above and are reiterated herein.

The Kirk-Othmer Encyclopedia of Chemical Technology fails to remedy these deficiencies. Although this reference discloses that carboxylated chloroprene rubber has good adhesive strength and high temperature cohesive strength, it fails to disclose or suggest the specific combination of the claimed invention, namely the use of carboxylated chloroprene as the main ingredient.

JP1-153781 describes a liquid type of a conventional self-crosslinking chloroprene adhesive including chlorinated polypropylene. The addition of chlorinated polypropylene is considered known in the art.

However, the present invention increases the adhering properties of the conventional adhesive compositions including chlorinated polypropylene. Also, JP1-153781 fails to disclose

or suggest the specific combination of the claimed invention, wherein carboxylated chloroprene is used as the main ingredient.

Further, it is well established that references cannot be combined where a reference teaches away from their combination. See M.P.E.P. § 2145, X, D, 2. As previously discussed above, Sato teaches away from the claimed composition, because Sato's composition requires large amounts of uncarboxylated chloroprene, which is excluded by the amended claims. Thus, assuming arguendo that the admitted state of the prior art, Smith, and Kirk-Othmer disclose the use of carboxylated chloroprene as the main ingredient in an adhesive composition, which they do not, the references could not be combined in view of the teaching away in Sato.

In view of the above, the rejection of claims 1 and 3 under 35 U.S.C. § 103 is untenable and should be withdrawn.

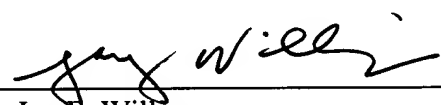
CONCLUSION

In view of the foregoing amendments and remarks, the present application is in condition for allowance and notice to that effect is hereby requested.

If it is determined that the application is not in condition for allowance, the Examiner is invited to telephone the undersigned attorney to expedite prosecution of the present application.

Respectfully submitted,

Kazurou OKUZAWA et al.

By: 

Jay P. Williams

Registration No. 48,036

for

Matthew M. Jacob

Registration No. 25,154

Attorneys for Applicants

MJ/JFW/akl
Washington, D.C. 20006-1021
Telephone (202) 721-8200
Facsimile (202) 721-8250
August 17, 2005